

Docket No.: 086645-0030

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Letters Patent of:
Asaki et al.

Conf. No.: 5161

Patent No.: 7,494,997 (Appln. No. 10/519,722)

Art Unit: 1624

Issued: February 24, 2009

Examiner: BALASUBRAMANIAN,
VENKATARAMAN

For: AMIDE DERIVATIVE

REQUEST FOR CERTIFICATE OF CORRECTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a request for a Certificate of Correction under 37 CFR 1.322(a)(1) to correct a mistake, incurred through the fault of the Patent & Trademark Office ("the Office), in the calculation of the patent term adjustment (PTA) in U.S. Patent No. 7,494,997.

Upon review of the file history for the above-identified patent, patentee respectfully requests the following correction be made of record:

At (*) **Notice:** (first column on the cover page), please delete "**Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 99 days**" and substitute – **Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 319 days --.**

Transmitted herewith is a proposed Certificate of Correction effecting such amendment. Patentee respectfully solicits the granting of the requested Certificate of Correction.

As set forth below, the mistake is clearly disclosed in the records of the Office. As such, the correction is amenable to a Certificate of Correction.

U.S. Patent No. 7,494,997 was filed as Application No. 10/519,722 on December 28, 2004 and issued on February 24, 2009. The '997 patent is entitled to a PTA of 319 days under a correct interpretation of 35 U.S.C. § 154 and in accordance with the Federal Circuit's decision in *Wyeth v. Kappos*, 591 F.3d 1364 (Fed. Cir. 2010) (*Wyeth*). The PTO granted only 99 days using a calculation that was determined to be incorrect in *Wyeth*.

Patent Term Adjustment under 35 U.S.C. § 154

35 U.S.C. § 154 guarantees that the PTO will provide at least one notification under section 132 or a notice of allowance not later than 14 months after the date on which the application was filed, and subsequent notifications within four months of an applicant's response. PTO delays beyond these times are referred to as "A" delays.

35 U.S.C. § 154 further guarantees no more than a 3-year application pendency. This does not include time consumed by continued examination requested by the applicant. PTO delays beyond this 3-year period are referred to as "B" delays. PTO delays do not include "overlap" under 35 U.S.C. § 154(b)(2)(A). Applicant delay is deducted from the PTO delay to arrive at the PTA.

In *Wyeth*, the Federal Circuit stated that there is no overlap "unless the violations occur at the same time." *Id.* at 1369-70. According to *Wyeth*, an applicant can be entitled to both A and B delays when no B delay occurs before the 3-year pendency date. Thus, there can be no overlap for A delays occurring before the 3-year pendency date.

The PTO calculated 99 days of PTA for the '997 patent. As illustrated below, the correct calculation under *Wyeth* is 319 days.

(a) A Delay

The application resulting in the '997 patent was filed on December 28, 2004. The PTO mailed a non-final Office Action on October 6, 2006. The PTO Action was 220 days beyond 14 months from the filing date, resulting in a 220 day A delay.

(b) B Delay

The '722 application was filed on December 28, 2004. The patent issue date was February 24, 2009. This resulted in a B delay of 271 days as follows. Three years from December 28, 2004 is December 28, 2007. The interval between December 28, 2007 and the February 24, 2009 issue date is 271 days.

(c) Overlap

The overlap is the period of A delay extending beyond the 3-year pendency date into the B delay period. Here, there is no overlap.

(d) Applicant Delays

(i) Applicant delay was 87 days for the period in excess of three months from the non-final Office Action mailed October 6, 2006 to the Response after Non-Final Action filed April 3, 2007.

(ii) Applicant delayed 85 days for the period in excess of three months from Final Rejection mailed April 1, 2008 to the September 24, 2008 Request for Continued Examination (RCE).

(iii) Thus, the total applicant delay was $87 + 85 = 172$ days.

(e) Correct PTA

(i) As there was no overlap of A delay into B delay, the correct PTA is the total of A delay and B delay ($220 + 271 = 491$) minus Applicant delay (172). Therefore, the correct PTA is $491 - 172 = 319$ days.

Conclusion

As detailed above, the '997 patent should have been granted 319 days of PTA. The PTO incorrectly calculated 99 days of PTA. The mistake was made by the Office, and the PTO records clearly disclose the mistake. Accordingly, a Certificate of Correction reflecting the correct PTA of 319 days should be issued under 37 CFR 1.322(a)(1).

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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CERTIFICATE OF CORRECTION

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PATENT NO. : 7,494,997
APPLICATION NO. : 10/519,722; Conf. No. 5161
ISSUE DATE : February 24, 2009
INVENTOR(S) : Tetsuo Asaki, Taisuke Hamamoto, Yukiteru Sugiyama

It is certified that an error appears or errors appear in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

At (*) **Notice:** (first column on the cover page), the portion reading "99" should be changed to -319-.

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